



Attorney Docket No. A-70583/DJB/VEJ/RBE
Attorney Matter No. 461124-00054
Application No. 09/831,982

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Andrew Ewart SCOTT

Application No. **09/831,982**

Filed: **August 6, 2001**

For: **A DATA ACCESS SYSTEM AND
METHOD UTILIZING PROMPT
NAVIGATION LANGUAGES**

Art Unit: **2655**

Examiner: **Michael N. Opsasnick**

Docket No.: **A-70583/DJB/VEJ/RBE**

Certificate of Mail (37 C.F.R. § 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal service on the date shown below with sufficient postage as first class mail in an envelope addressed Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

June 8, 2006
[Signature]
Lukas K. Szymanski

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal along with a petition for a three-month extension of time.

The review is requested for the reasons stated below.

The undersigned is an attorney of record.

Applicants request pre-appeal review of the Examiner's rejection of claims 9-10, 22-23, and 35-36 under 35 U.S.C. § 102(e) over U.S. Patent No. 6,282,511 to Mayer ("Mayer").

Should the Panel find in favor of the Applicants, Applicants agree to amend any claim found allowable in independent form, including the limitations of the respective base claim and any intervening claim, thus rendering moot the Examiner's remaining rejections.

REMARKS**I. Clear Legal Error: Elements Missing from Mayer**

Claims 1-39 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Mayer. Claims 9, 22, and 35 call for WML as the “prompt navigation language.” Likewise, claims 10, 23, and 35 call for HDML.

Applicant respectfully submits that the Examiner has committed clear legal error by failing to indicate whether Mayer discloses a data access method including requesting data in a prompt navigation language wherein the language is WML or HDML as called for in claims 9 and 10 respectively. Each and every limitation of the claim must be found in the prior art in order to be anticipated. *See* M.P.E.P. § 2131.

In both the Office Action mailed December 8, 2005 (“the present Office Action”) and the Office Action mailed April 18, 2005 (“the April Office Action”), the Examiner rejected claims 9-10 without reference to the limitations called for in claims 9-10. The Examiner refers to Mayer as disclosing HTML throughout the previous Office Action without once mentioning WML or HDML. For example, in rejecting claims 9-13, the Examiner asserts that Mayer “teaches the use of the system over the internet, taking advantage of HTML, to simulate IVR.” *See* present Office Action, page 3 and April Office Action, page 4. Claims 10, 22-23, and 35-36 stand rejected “under similar rationale.” *See* present Office Action, page 3.

The Examiner has failed to indicate whether the limitations of claims 9-10 and similarly 22-23 and 35-36 are met by Mayer, namely whether Mayer discloses WML or HDML. Applicant respectfully submits that the Examiner has failed to show that Mayer teaches each and every element of claims 9-10, 22-23, and 35-36. *See* M.P.E.P. § 2131. As such, these claims have been improperly rejected under 35 U.S.C. § 102. Accordingly, Applicant respectfully submits that claims 9-10, 22-23, and 35-36 are allowable over the cited art.

II. Clear Factual Error: WML and HDML distinct from HTML

Claims 1-39 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Mayer. Claims 9 and 10 call for WML and HDML, respectively, as the “prompt navigation language” of the data access method of the present invention.

Based upon the Examiner’s response and the standing rejections, the Examiner appears to conclude that HTML reads on WML and HDML. In first rejecting claims 9-13, the Examiner argued that Mayer “teaches the use of the system over the internet, taking advantage of HTML, to simulate IVR.” *See* previous Office Action, page 3. As indicated in the previous response, Mayer refers to HTML 48 times and make reference to no other languages. In responding to Applicant’s previous arguments, the Examiner states that “HTML does not necessarily have to express visual data, and [sic] thereby qualifying HTML has a ‘prompt navigation language.’” *See* present Office Action, page 4. Further, as indicated above, the Examiner does not assert even once that Mayer discloses use of WML nor HDML as called for in claims 9-10 respectively. Thus, the Examiner appears to implicitly accept Applicant’s argument that Mayer discloses use of HTML only and instead argues that use of WML and HDML is anticipated by use of HTML.

Applicant respectfully submits that Examiner’s conclusion that the disclosure of HTML anticipates WML and HDML is a clear factual error. Admittedly, WML (wireless markup language) and HDML (handheld dynamic markup language) are derived from XML and HTML, respectively. Also, WML, HDML, and HTML are all markup languages and thus present data in similar ways conceptually. However, WML and HDML are separate and distinct languages from HTML.

With the advent of mobile phones capable of accessing data, there arose the problem of overcoming the inherent restrictions of existing phones. In particular, resolution and size limitations of phone displays prevented adequate display of traditional HTML pages. WML and the WAP (wireless access protocol) were thus developed to overcome these mobile phone restrictions and also to add features of particular importance in mobile applications. Based on the goal of creating a new language capable of presenting data universally on mobile devices, a

new set of technical specifications were proposed. *See* specification and NOTES maintained by the World Wide Web Consortium and available at www.w3.org.

Therefore, although WML has similarities to HTML, there are distinct technical differences between the languages. For example, the WML standard calls for different lexicography, syntax, structure, and input masks. In fact, many pages coded in WML cannot be accessed with standard HTML browsers or similar run-time environments. Furthermore, the WML specification calls for different structure, presentation, and style than HTML.

Similarly, HDML is a distinct language from HTML. Although HDML is based upon HTML and is identified and cached similarly to HTML and WML, HDML has distinct conceptual and technical differences from HTML. In particular, HDML includes security features, data presentation standards, and variable handling that are distinct from HTML.

Additionally, both HDML and WML have broad conceptual differences from HTML. For example, HDML is grouped into cards in a deck and navigation is structured around activities in related cards. In contrast, the HTML standard has no such limitation.

Applicant respectfully submits that the Examiner has committed a clear factual error by equating HTML to WML and HDML. As previously argued and noted above, Applicant submits that Mayer fails to disclose WML or HDML as the requested data as called for by claims 9-10 respectively. Because WML and HDML are based on an entirely different set of rules, they are mutually exclusive from HTML. Claims 22-23 and 35-36 call for the same subject matter of claims 9-10 and thus are submitted to be allowable for the same reasons noted above.

CONCLUSION

Applicants respectfully request that the Panel reconsider and withdraw the rejections over 9-10, 22-23, and 35-36 in view of Mayer. Applicants further request that prosecution on the merits be reopened so that Applicants may rewrite claims 9-10, 22-23, and 35-36 in independent form.

If the Examiner or the Panel believe, for any reason, that personal communication will expedite prosecution of this application, the Examiner or the Panel are invited to telephone the undersigned at the number provided below.

The Commissioner is hereby authorized to charge any underpayment of the following fees associated with this communication, including any necessary fees for extension of time and for the presentation of extra claims, or credit any overpayment to Deposit Account No. 50-2319 (Order No. 461124-00054; Docket No. A-70583/DJB/VEJ/RBE).

Prompt and favorable consideration of this Request is respectfully requested.

Respectfully submitted,

Date: 6/8/06

By: 

Victor E. Johnson, Reg. No. 41,546

DORSEY & WHITNEY LLP
Suite 1000
555 California Street
San Francisco, California 94104-1513
Telephone: (415) 781-1989 Facsimile: (415) 398-3249